

REMARKS

Claims 1-32 are pending in the instant application. In the outstanding Office Action, the Examiner has rejected claims 1, 3-7, 10-16, 18-20, 23-25, and 28-32 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,175,922 B1 to Wang (hereinafter, Wang). The Examiner has rejected claims 21-22 and 26-27 under 35 U.S.C. § 103(a) as being obvious over Wang in view of U.S. Patent No. 6,256,664 to Donoho et al (hereinafter, Donoho). The Examiner has also rejected claims 2, 8, 9, and 17 under 35 U.S.C. § 103(a) as being obvious over Wang in view of U.S. Patent No. 6,269,336 B1 to Ladd et al (hereinafter, Ladd). Finally, the Examiner has rejected claims 1-6, 21, and 31-32 under 35 U.S.C. § 112, first paragraph.

As an initial matter, the Applicant was under the impression that novelty over Wang had already been demonstrated respecting at least claims 1, 3-7, 10-16, and 18-20. The Examiner initially rejected those claims under 35 U.S.C. § 102(e) in an Office Action dated 7/3/2002. The Applicant amended independent claims 1, 7 and 16 in a Response dated 9/6/2002, and the Examiner did not re-assert the novelty rejection in the subsequent Office Action dated 11/8/2002. The latest Office Action re-instated the 102 (e) rejection as to the same previously-cited reference. Changing of Examiners during prosecution should not work to penalize an applicant. The Applicant still believes that the claim amendments made in the Response dated 9/6/2002 patently distinguish over Wang. Due to pragmatic concerns not related to the issue of patentability, the Applicant chooses to amend the independent claims in order to move this application toward issue without conceding lack of novelty for the claims as previously submitted.

In paragraph 8 of the Office Action dated 3/6/2003, the Examiner rejected claims 2, 8, 9, and 17 under Wang in view of Ladd. The Examiner characterized Wang as teaching a PIN entered at an ATM that is then compared to a PIN stored at a remote site, but that Wang fails to provide a user entering a PIN into a mobile station. The Examiner characterized Ladd as teaching a PIN entered into a mobile station for user identification. Applicant agrees as to those respective teachings. However, Wang's teaching above is described as prior art, and Wang further teaches at col. 2, line 30-44 that entering a PIN

as in the prior art is a security shortfall to be overcome. One object of Wang, cited at col. 2, lines 63-65, is to substantially overcome the risk of unauthorized procurement of a user's identification data. The difference between Wang and the prior art is explicitly stated at Wang, col. 5, line 30-39, (the prior art requires a user to enter identification data such as a PIN to authenticate himself, whereas Wang keeps identification data related to the user within the PEAD at all times). It is contended that Wang cannot be modified such that a user PIN number is entered at a mobile station without violating explicit teachings of the reference.

Furthermore, Ladd is directed to interactive voice-activated web services. In Applicant's reading, each and every teaching of Ladd relating to entering a PIN or other personal authentication refers to entry via voice commands or audible tones. See Ladd, col. 4, lines 15-18; col. 6, lines 50-55; and col. 19, lines 55-59. Applicant presumes that spoken PINs are even more susceptible to unauthorized procurement than keyboard-entered PINs that Wang rejects. A skilled artisan looking to improve Wang therefore would not look to the teachings of Ladd, which reduces the security concerns that permeate Wang. There appears no motivation within the references to combine the two, and the above citations appear to show an explicit motivation not to do so. Applicant hereby requests the Examiner reconsider his combination of Wang and Ladd for personal authentication purposes in light of the above.

Each of claims 2, 8, 9, and 17 concern entering personal authentication at a mobile station. Applicant has cancelled each of them and rewritten the relevant independent claims to include the respective dependent subject matter concerning entry of personal authentication. Applicant requests the Examiner reconsider his combination of Wang with Ladd and withdraw his rejections based thereon that would otherwise be imputed to claims 1, 7, 9 and 16, as amended herein.

The Examiner has rejected claims 1, 3-7, 10-16, and 18-20 (among others) as not novel over Wang. Applicant respectfully requests the Examiner withdraw his novelty rejection to claims 3-6, 10-15, and 18-20 in light of their dependence from claims 1, 7, 9 or 16 as

amended herein. Applicant further requests that the Examiner withdraw the obviousness rejection to claim 21 based on its dependence from herein-amended claim 1.

The Examiner has rejected claims 21-22 and 26-27 as obvious over the combination of Wang with U.S. Patent No. 6,256,664 B1 to Donoho et al (hereinafter, Donoho). As detailed above in the discussion of the combination of Wang with Ladd, Wang teaches away from prompting a user to enter personal authentication information using one of a computer user interface or a mobile station user interface as recited in claim 22. Donoho does not include such teaching, and the Examiner does not so allege.

Additionally, claim 22 recites that the received challenge is detected based on message parsing that comprises MIME field recognition. While Donoho does teach parsing of messages using MIME, the approach of Wang appears to counsel against using MIME for security purposes. In each embodiment described in the Summary of Invention of Wang, col. 3, the requesting device receives from the server a transaction program which includes an executable portion (EP) that communicates with the PEAD. Claim 22 does not require downloading code from a server; the specification describes a plug-in or application already resident on the computer. In that instance, only messages are transmitted between the mobile station, computer, and site to satisfy claim 22, not code as required by Wang. Wang's failure to describe how PEAD messages are detected also seems to infer a proprietary communication channel. For security purposes, a proprietary channel is preferable to publicly known methods such as MIME, so Wang's lack of disclosure concerning message recognition seems to teach away from employing a known message recognition protocol such as MIME.

For at least the above reasons, the Applicant respectfully requests the Examiner withdraw his obviousness rejection to claim 22 and pass it to issue. Claims 26-27 depend from claim 23, and are also deemed to be patentable for the reason, argued below, with respect to claim 23.

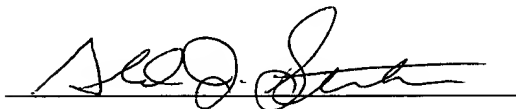
In addition to certain claims recited above, the Examiner has rejected claims 23-25 and 28-32 as lacking novelty over Wang. The Applicant has herein amended claim 31 to incorporate the subject matter of claim 32. Claims 23, 30 and 31 are independent claims from which all remaining claims grouped immediately above depend. Each of claims 23, 30 and 31 recite (in similar but not identical language) a list of certificates, accessible by the mobile station, that are applicable to the request. Applicant is unaware of any teaching within Wang that contemplates a list of certificates that are applicable to the transaction request and accessible by a mobile terminal. It appears that a PEAD as disclosed in Wang would not be operable with such a list, as Wang teaches that the only options available for a user of the PEAD is "accept" or "skip". Even if it were made to be operable to select from a list of certificates, it appears Wang teaches away from such a modification by the security concerns described above that pervade the reference. As such, the Applicant respectfully requests the Examiner either more particularly point out the relevant teaching in Wang, or reconsider and withdraw the novelty rejection of claims 23-31 as amended herein.

Finally, the Examiner has rejected claims 1-6, 21, and 31-32 as not enabled under 35 USC §112, first paragraph. The Examiner has graciously suggested inserting a step (sending a request from the mobile station to the computer) into the relevant independent claims to overcome this rejection. Applicant sincerely appreciates the suggestion but respectfully declines to adopt it. The Office Action does not appear to indicate that the specification is deficient, only that the claims leave out what the Examiner deems a critical step. 35 USC §112, first paragraph, recites that the specification must be enabling, not the claims alone. The specification includes both the claims and the written description (with drawings). The claims recite what the applicant regards as his invention, and in an issued patent they set forth the metes and bounds of legal rights. Applicant believes that there is no requirement that steps of a method claim be sufficiently enabling in and of themselves, but that they recite the patentably distinct aspects of the inventive method.

Respecting the Examiner's contention that it is a critical step, Applicant poses an example: a user ordering a book from a commerce-related site from his personal desktop computer at home. The user may access the site, select the book, and enter non-authorizing data such as shipping address, shipping mode, etc. directly at the desktop computer without using a mobile terminal. To consummate the order with submission of credit card data, the user may do so with his mobile terminal through a bluetooth connection with the computer, as a convenience over looking up and manually entering the information. The transaction was not initiated from the mobile terminal, but was consummated therefrom. Applicant asserts that the above example, wherein all other limitations of the relevant claims are met, is within the scope of the present invention. Applicant respectfully requests the Examiner withdraw his rejection under § 112, or more particularly point out where the specification is deficient in enabling one of ordinary skill to practice the invention.

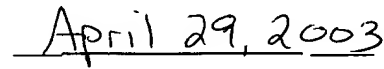
Applicant submits that the above detailed arguments successfully traverse each and every outstanding rejection. Applicant requests the Examiner withdraw all rejections to the remaining claims as herein amended and pass this application to issue without further delay. Applicant's undersigned attorney welcomes the opportunity to resolve any remaining issues via teleconference, at the contact numbers below, as the Examiner deems appropriate.

Respectfully submitted:



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VERSION WITH MARKINGS TO SHOW CHANGES

1. (Thrice Amended) A method for conducting electronic commerce, comprising steps of:

operating a computer to contact a commerce-related site using a browser;

automatically detecting a presence of a message received from the commerce-related site that requires, as a response, non-stored authentication information inputted by a user in response to the detected presence of the message;

in response to automatically detecting the presence of the message, sending a message from the computer to a mobile station over a bi-directional transmission link;

in response to receiving the message over the link, generating a user authentication message that is generated by prompting the user to enter a personal identification number (PIN) and comparing the entered PIN to a PIN stored in the mobile station ~~non-stored user input at the mobile station;~~

passing the user authentication message from the mobile station to the computer over the bi-directional transmission link; and

sending user authentication information from the computer to the commerce-related site using the browser.

7. (Twice Amended) A system for conducting communication with a site reachable through a data communications network, comprising:

a mobile station comprising a user interface and a mobile station utilization application; and

CD a computer coupled to a data communications network and comprising a browser for contacting the site through the data communications network, the computer and browser operating to automatically detect a presence of a received message for the site that requires a response from the user, and further comprising an interface for sending a message from the computer to the mobile station over a bi-directional link in response to automatically detecting the presence of the message;

said mobile station utilization application being responsive to the receipt of the message from the link for generating a user response message and for passing the user response message to the computer over the link, said mobile station operating to prompt the user to enter a personal identification number (PIN) into the mobile station and to compare the entered PIN to a PIN stored in the mobile station; and

said computer being responsive to a receipt of said user response message for sending user response information to the site using said browser.

16. (Twice Amended) A method for conducting communication with a site reachable through a data communications network, comprising steps of:

providing a mobile station having a user interface and an application;

coupling a computer to a data communications network, the computer having a browser for contacting the site through the data communications network;

automatically detecting with the computer a presence of a received message from the site that requires a response from the user;

in response to automatically detecting the presence of the received message, sending a message from the computer to the mobile station over a bi-directional link;

responsive to the receipt of the message in the mobile station; and an input of a personal identification number (PIN) and a comparison of the inputted PIN to a PIN stored in the mobile station, generating a user response message and passing the user response message to the computer over the link; and

responsive to a receipt of the user response message in the computer, sending user response information to the site using the browser.

31. (Amended) A method for conducting communication with a server, comprising:

coupling an access application running on a computer to the server through a data communications network;

automatically detecting a presence of a request that is received from the server, the request being one that requires an authentication of a user;

in response to automatically detecting the presence of the request, sending a message from the computer to a mobile station over a link; the message comprising an inquiry for a list of certificates that are application to the request, the certificates being accessible by the mobile station;

presenting the list of applicable certificates to the user for selecting one of the presented certificates;

using the mobile station to communicate with a source of the selected certificate for completing the certificate which comprises a user authentication message;

passing the completed certificate over a link to the access application running on the computer;

~~in response to receiving the message over the link, generating a user authentication message in the mobile station;~~

~~passing the user authentication message from the mobile station to the computer over the link; and~~

responsive to a receipt of the completed certificate, sending user authentication information to the server using the access application.